



PATENT
Atty. Dkt. MRKS/0012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Pietras, et al.

Serial No.: 09/509,073

Confirmation No.: 5424

Filed: August 22, 2000

For: An Apparatus for Facilitating
the Connection of Tubulars
Using a Top Drive

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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Group Art Unit: 3672

Examiner: J. Hawkins Gay

~~CE~~ #22 Appeal
Bridget
Evans
6/14/02

APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 3672 dated September 14, 2001, finally rejecting claims 15-16 and 26-35. Please charge the fee of \$320.00 for filing this brief to Deposit Account No. 20-0782/MRKS/0012/WBP. Three copies of this brief are submitted for use by the Board.

Real Party in Interest

The present application has been assigned to Weatherford/Lamb, Inc., 515 Post Oak Boulevard, Suite 600, Houston, Texas, 77027.

06/11/2002 AWONDAF1 00000152 200782 09509073

02 FC:120 320.00 CH

Related Appeals and Interferences

Appellants assert that no other appeals or interferences are known to the Appellants, the Appellants' legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 15-16 and 26-35 are pending in the application. The rejection of the pending claims, which are shown in the attached Appendix, is appealed.

Claims 1-25 were originally filed and claims 26-35 were subsequently added in Applicants' response to Office Action dated March 29, 2001. Applicants cancelled claims 17-25 in Applicants' response to Office Action dated March 29, 2001 to pursue in a divisional application, and Applicants also cancelled claims 1-14 to reduce issues for appeal in Applicants' response to Final Office Action dated September 14, 2001. Accordingly, claims 15-16 and 26-35 remain pending in the application.

Status of Amendments

The claims in the Appendix include amendments made to claims 15 and 16 presented in a response to Office Action dated March 29, 2001. No other pending claims were amended.

Summary of the Invention

An apparatus for connecting tubulars is provided. In one aspect, the apparatus includes a body (2, 102) connectable to a top drive (33) and at least one gripping element (5, 105) radially displaceable by hydraulic or pneumatic fluid to drivingly engage a tubular (30, 110) as shown in Figures 1-3. The at least one gripping element (5, 105) engages an inner wall (31, 111) of the tubular (30, 110) so that rotational force can be transmitted from the apparatus to the tubular (30, 110). (See specification at paragraph 42, page 9.) As the apparatus is rotated by the top drive (33), the engaged tubular (30, 110) is screwed into an adjoining tubular to a required torque. (See specification at paragraph 5, page 3.) Accordingly, the apparatus does not require a separate tool to tighten the connected tubulars to a required torque. (See specification

at paragraph 8, page 3.) For at least this reason, the apparatus beneficially reduces the time and costs associated with constructing an oil and gas well. (See specification at paragraph 3, page 2.)

In another aspect, the apparatus further includes a sealing packer (107) that is actuated by hydraulic or pneumatic fluid, as shown in Figure 3. The sealing packer (107) inhibits fluid from passing/escaping between the apparatus and an engaged tubular (110). (See specification at paragraph 42, page 9.) This is particularly advantageous when circulating fluid to facilitate running a string of tubulars downhole. For example, if a string of tubulars becomes lodged on an obstruction within the hole, fluid can be pumped down the string via passage (103) under high pressure to remove the obstruction. The sealing packer (107) prevents the high pressure fluid from escaping through the top of the string. (See specification at paragraph 42, page 9.)

Issues Presented

Whether the Examiner erred in rejecting claims 15-16 under 35 U.S.C. § 102(a) as being anticipated by Gjebedo (WO 98/11322).

Whether the Examiner erred in rejecting claims 26-32, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Gjebedo* (WO 98/11322) in view of *Delano* (U.S. Patent. No. 4,100,968).

Grouping of Claims

Pending claims 15-16 stand together and claim 15 is representative of Applicants' argument. Claims 26-35 stand together and claim 26 is representative of Applicants' argument.

Arguments

I. THE EXAMINER ERRED IN REJECTING CLAIMS 15-16 UNDER 35 U.S.C. § 102(A) AS BEING ANTICIPATED BY GJEBEDO (WO 98/11322).

Claims 15-16 stand rejected under 35 U.S.C. § 102(a) as being anticipated by *Gjebedo* (WO 98/11322). The Examiner states that *Gjebedo* discloses an inflatable elastomeric gripping member that also functions as a sealing packer.

Applicants respectfully traverse the rejection on grounds that not all of the claim limitations are taught or suggested by the prior art. *Gjebedo* discloses an inflatable bellows that is clamped about a pipe member. The bellows is an elastic material such as rubber or plastic and is hydraulically inflated to engage an inner surface of a surrounding tubular, and is used to transmit rotational torque to the surrounding tubular. However, *Gjebedo* does not expressly or inherently teach or suggest a sealing element and a gripping element, as recited in claims 15-16.

The prior art must teach all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Furthermore, a prior art device cannot anticipate a claim if there is any structural difference between the claim and the prior art device, even if the prior art device performs all the functions recited in the claim. See *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

Therefore, the Examiner erred in rejecting claims 15-16 under 35 U.S.C. § 102(a) as being anticipated by *Gjebedo* (WO 98/11322) on the basis that the inflatable elastomeric gripping member also functions as a sealing packer. Withdrawal of the rejection is respectfully requested.

Furthermore, claims 15-16 are not obvious in view of *Gjebedo* (WO 98/11322). *Gjebedo* explicitly teaches rotating the surrounding tubular engaged with the inflatable bellows to connect said tubular with another. *Gjebedo* then explicitly teaches tightening the connected tubulars with a separate moment tool to achieve a desired torque. (See

Gjebodo at page 7.) Therefore, *Gjebodo* does not teach, show or suggest “at least one gripping element radially displaceable to drivingly engage a tubular... and a further tubular to be tightened to a required torque”, as recited in claims 15-16. Accordingly, claims 15-16 are patentable over *Gjebodo*. Allowance of the claims is respectfully requested.

II. THE EXAMINER ERRED IN REJECTING CLAIMS 26-35 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER GJEBODO (WO 98/11322) IN VIEW OF DELANO (U.S. PATENT NO. 4,100,968).

Claims 26-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gjebodo* (WO 98/11322) in view of *Delano* (U.S. Pat. No. 4,100,968). The Examiner states that *Gjebodo* (WO 98/11322) “teaches all the claimed limitations except for the upper portion of the body including spline recesses and the gripping member having blades.” The Examiner also states that *Delano* discloses an apparatus used to run casing into a wellbore. The Examiner further states that *Delano* discloses an upper section having a series of blade shaped slip sections that are controlled by a pressure sensitive piston and spring. The Examiner further states that the upper portion of the slip section includes a set a spline recesses and engage the splines on a conduit that “connects to apparatus to traveling block.” The Examiner, therefore, asserts that it would have been obvious “to have included the spline recess of *Delano* on the device of *Gjebodo* in order to have been able to easily detach and replace the device when necessary”.

The Examiner’s position subsequent to Final rejection is that *Delano* teaches recesses that include displaceable gripping element. The Examiner states that “although these elements are not displaced by pneumatic or hydraulic fluid, this feature is taught in the primary reference” (*Gjebodo*).

Applicants respectfully traverse the rejection on grounds that the Examiner has not established *prima facie* obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success

must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Still further, the examiner must particularly identify any suggestion, teaching or motivation from within the references to combine the references. See *In Re Dembiczkak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. (See M.P.E.P. § 2143.01.)

The Examiner has not provided motivation or suggestion from within the prior art to combine their teachings. Furthermore, all the claim limitations are not taught or suggested by a combination of the references. As properly stated by the Examiner, *Gjebedo* does not teach or suggest "at least one recess disposed about an outer surface of the body, wherein each recess comprises a gripping element", as recited in claim 26 and those dependent therefrom. Likewise, *Gjebedo* does not teach or suggest "one or more recesses disposed about an outer diameter of the second section; and a radially expandable gripping element disposed with each recess", as recited in claim 29 and those dependent therefrom.

Delano discloses a device for running casing into a wellbore. The device includes a slip section 44 having a recess 144 in which is positioned a piston 146 rigidly mounted on a slip cage 148. The piston 146 and the slip cage 148 move downwardly in response to the delivery of pressurized air into the chamber afforded by the recess 144. As shown in Figure 3 of the reference, the slips are not disposed within the recess 144, but are disposed below the recess having the piston 146 disposed therebetween. (See *Delano* at column 4, lines 45 through 68 and at Figure 3.) Therefore, *Delano* does not teach, show, or suggest at least one recess having a gripping element disposed therein as recited in claims 15-16 and 26-35. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Conclusion

The references cited by the Examiner, neither alone nor in combination, teach, show, or suggest the claimed invention. Withdrawal of the rejections and allowance of claims 15-16 and 26-35 is respectfully requested.

Respectfully submitted,



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APPENDIX A

THE PENDING CLAIMS:

15. An apparatus for connecting tubulars using a top drive, comprising:
 - a body connectable to said top drive;
 - at least one gripping element radially displaceable to drivingly engage a tubular to permit a screw connection between said tubular and a further tubular to be tightened to a required torque; and
 - a sealing packer to inhibit, in use, fluid in said tubular from escaping therefrom.
16. The apparatus as claimed in claim 15, wherein said sealing packer can be actuated by hydraulic or pneumatic fluid.
26. An apparatus for connecting tubulars, comprising:
 - a top drive;
 - a body connectable to the top drive; and
 - at least one recess disposed about an outer surface of the body, wherein each recess comprises a gripping element,
 - wherein the gripping element is radially displaceable by hydraulic or pneumatic fluid to engage a first tubular.
27. The apparatus of claim 26, wherein the gripping element transfers rotational torque from the top drive to permit a screw connection between the first tubular and a second tubular.
28. The apparatus of claim 27, wherein the screw connection is tightened to a prescribed moment.
29. An apparatus for connecting tubulars, comprising:
 - a top drive;
 - a body having a first and second section;
 - one or more recesses disposed about an outer diameter of the second section; and

a radially expandable gripping element disposed with each recess.

30. The apparatus of claim 29, wherein the first section comprises a splined recess into which a splined connecting member may be located.

31. The apparatus of claim 29, wherein the gripping elements are radially expandable with pressurized hydraulic or pneumatic fluid.

32. The apparatus of claim 29, wherein the gripping elements are radially expanded to engage an inner surface of a tubular.

33. The apparatus of claim 32, further comprising one or more compensating pistons, wherein the pistons are pneumatically operable and adjustable to compensate for different weights of the tubular.

34. The apparatus of claim 29, wherein the body is connected to the top drive.

35. The apparatus of claim 34, wherein the top drive provides rotational torque to permit a screw connection between one or more tubulars.